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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/574,689	12/19/95	APPINO	J 5023/P58317A

15M1/0129

JACOBSON PRICE HOLMAN AND STERN
THE JENIPER BUILDING
400 SEVENTH STREET NW
WASHINGTON DC 20004-2201

BAHA, R	ART UNIT	PAPER NUMBER
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1502
DATE MAILED: 01/29/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 10-7-96

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 10-17 and 23-28 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 10-17 and 23-28 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

BEST AVAILABLE COPY

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Part III DETAILED ACTION

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The new abstract is accepted.
3. Claims 10-17 and 23-28 are still rejected under 35 U.S.C. § 103 as being unpatentable over McCrea et al. Applicant's arguments filed on October 7, 1996 have been fully considered but they are not deemed to be persuasive. A clear case of prima facie obviousness has been established in view of the art and reasons of record.

The applicants argue that the cited art does not disclose "a "container" cooperating with "a flow value extending into said container, and a means of propulsion" (page 5 of response). First, such nominal canisters are well known to deliver topically-active compounds (cosmetics or drugs). Second, the cited art is directed to "topical delivery of a topically-active compound, either cosmetic or medicinal ..." (column 2, lines 19-20 of McCrea et al.). Additionally, such topical compositions are routinely packaged as pump-sprays (e.g., see column 1, lines 65-66 of McCrea et al.). Therefore, even though McCrea et al. does not specifically state that its composition can be packaged in "a

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"container" cooperating with "a flow valve extending into said container, and a means of propulsion", this is within the scope of McCrea et al. Also, the examiner emphasizes that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

With respect to the argument concerning "spraying on the skin" versus "topical delivery", note that the later phrase encompasses the former.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

The cited art is analogous because it pertains to the field of the inventor's endeavor and is also reasonably pertinent of the particular problem with which the inventor is involved. *In re Wood*, 202 USPQ 171, 174. Note that a comprising-type language does

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not exclude other steps, elements or materials. *Cues Inc. vs Polymer Industries*, USPQ2d 1847 (DC ND GA 1988). Moreover, (i) it is well established that the claims are given the broadest interpretation during examination; and (ii) a conclusion of obviousness under 35 USC 103 does not require absolute predictability, only a reasonable expectation of success. No criticality of the concentrations of the ingredients has been established. No comparative data over the closest prior art demonstrating any unexpected results and/or improvements has been demonstrated.

In light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 USC 103.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Raj Bawa, Ph.D., whose telephone number is (703) 308-2423. The Examiner can normally be reached on Tuesday-Friday from 7:30 a.m. to 6:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Page, can be reached on (703) 308-2927. The fax number for this Group is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.



RAJ BAWA, Ph.D.
PRIMARY EXAMINER
GROUP 1500

Mr. Raj Bawa, Ph.D.:cb
Friday, January 17, 1997
Tuesday, January 28, 1997